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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/813,446	03/20/2001	Olav Solgaard	UC97-156-7	3284

7590 03/22/2002  
John P. O'Banion  
O'BANION & RITCHEY LLP  
Suite 1550  
400 Capitol Mall  
Sacramento, CA 95814

EXAMINER

LEE, JOHN D

ART UNIT	PAPER NUMBER
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2874

DATE MAILED: 03/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/813,446

Applicant(s)

Olav Solgaard et al.

Examiner

John D. Lee

Art Unit

2874



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Feb 5, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 31-94 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-94 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9 & 10
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

Applicant's communication submitted on February 5, 2002, has been carefully studied by the Examiner. The arguments advanced therein, considered together with the amendments made to the claims, are persuasive and the rejections based upon prior art made of record in the previous Office action are withdrawn. Applicant's provisional application has now been reviewed, and it has been determined that applicant is indeed entitled to the priority date of February 13, 1997. U.S. Patent 6,212,309 to Nguyen et al is thus removed as a reference against the claims of the present application. With respect to Wu (U.S. Patent 5,581,643), this reference does not disclose or suggest the wavelength separation aspect of an optical switch which is now specifically set forth in the claims. Applicant's amendments have also obviated the previously applied 35 U.S.C. § 112 rejection, as well as the objection to the abstract. The subject matter of applicant's pending claims is now deemed to patentably distinguish over the prior art of record herein. The Terminal Disclaimer submitted on February 5, 2002, has overcome the double patenting rejection based upon U.S. Patent 6,289,145, but has not addressed the double patenting rejection based upon copending U.S. Application Serial Number 09/849,096. That rejection must therefore be maintained.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR § 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR § 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR § 3.73(b).

Claims 31-94 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 31-64 of copending Application No. 09/849,096. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons. The chart set forth below shows the correspondence of the claims from the present application and the claims from copending Application No. 09/849,096. The claims differ only semantically (i.e. the various use of the words "an", "any", "at least one") and effectively claim the same invention. There is no patentable distinction between the respective sets of claims.

U.S. Application No. 09/813,446

U.S. Application No. 09/849,096

31-36  
37-38  
39-40  
41-44  
45-50  
51-52  
53-54  
55-58  
59-64  
65-66  
67-68  
69-76

31-32  
33-34  
35-36  
37-40  
41-42  
43-44  
45-46  
47-50  
51-52  
53-54  
55-56  
57-64

In addition, claims 77-94 of the present application are not patentably distinct from the claims of copending Application No. 09/849,096 since they recite combinations of other claims in the present application, as follows (which claims were all covered in the above chart).

Claim Number Herein

Same as Combination of Claims

77-79	67 + 71
80	67 + 71 + 68
81	67 + 71 + 72
82	67 + 71 + 73
83	67 + 71 + 74
84	67 + 71 + 75
85	67 + 71 + 76
86-88	67 + 74
89	67 + 74 + 68
90	67 + 74 + 75
91	67 + 74 + 76
92	67 + 74 + 69
93	67 + 74 + 70
94	67 + 74 + 71

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

All of the prior art documents cited and/or submitted by applicant in the Information Disclosure Statements filed on November 19, 2001, and January 23, 2002 have been considered and made of record (note the attached copy of forms PTO-1449). It is noted that these two Information Disclosure Statements are identical. Neither of the cited documents discloses or suggests the optical switch set forth in the claims of this application.

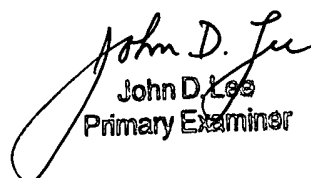
The present application is one of a large number of related applications having similar claims. In addition to the copending applications mentioned on page 1 of the specification herein, the Examiner is also aware of copending applications Serial Nos. 09/849,096 (filed May 4, 2001) and 09/928,237 (filed August 10, 2001). There may be other related applications unknown to the Examiner. Accordingly, in order for the Examiner to accurately assess all potential double patenting situations, applicant is required to submit the following in response to this Office action: a copy of

all claims presently pending in each of the above identified copending related applications (as well as any other copending related applications known to applicant). Applicant is *not* required to submit a copy of claims which are no longer pending (i.e. canceled) in these applications.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR § 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and an advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR § 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning the merits of this communication should be directed to Examiner John D. Lee at telephone number (703) 308-4886. The Examiner's normal work schedule is Tuesday through Friday, 6:30 AM to 5:00 PM. Any inquiry of a general or clerical nature (i.e. a request for a missing form or paper, etc.) should be directed to the Technology Center 2800 receptionist at telephone number (703) 308-0956, to the technical support staff supervisor (Team 2) at telephone number (703) 308-3072, or to the Technology Center 2800 Customer Service Office at telephone number (703) 306-3329.

  
John D. Lee  
Primary Examiner